

REMARKS

An Office Action has been issued in the subject application which outlined the following rejections:

- claims 10, 11, 16, 17, 19, and 20 under 35 U.S.C. § 112; and
- claims 1-10 and 12-20 under 35 U.S.C. § 103.

Summarizing the Amendment, claims 4, 10, 11, and 16-20 have been amended and new claims 21-24 have been added to more particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-24 remain in the application.

Reconsideration and reexamination of the subject application in view of the amendments and the following remarks are respectfully requested.

REJECTIONS UNDER 35 U.S.C. § 112

Claims 10, 11, 16, 17, 19, and 20 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant traverses these rejections.

Claims 10, 11, 16, and 17 have been amended to provide antecedent basis for “the pair of contact” as requested by the Examiner. In addition, the respective dependencies of claims 17, 19, and 20 have been corrected, thereby correcting the outlined antecedent issues.

The Office Action states that “it is unclear how ‘contacts of the file’ is different from contacts of the circuitry.” For clarification, reference is made to the embodiment illustrated in FIG. 6 and corresponding description in paragraph 0040 in which a pair of contacts 160 are on a circuit and a pair of contact 162 are on a file. The examiner is invited to contact the undersigned if further clarification is required.

It is respectfully submitted that claims 10, 11, 16, 17, 19, and 20 as amended are patentable and in condition for allowance.

REJECTIONS UNDER 35 U.S.C. § 103

Claims 1 and 5-8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,045,652 to Tuttle et al. in view of U.S. Patent No. 5,751,221 to Stanfield et al.

Claims 2, 9, 10, 16, and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,045,652 to Tuttle et al. in view of U.S. Patent No. 5,751,221 to Stanfield et al. and U.S. Patent No. 6,201,474 to Brady et al.

Claims 3, 12, and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,045,652 to Tuttle et al. in view of U.S. Patent No. 5,751,221 to Stanfield et al. and U.S. Patent No. 5,936,527 to Isaacman et al.

Claims 4, 14, 15, and 18-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,045,652 to Tuttle et al. in view of U.S. Patent No. 6,121,880 to Scott et al.

Claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,045,652 to Tuttle et al. in view of U.S. Patent No. 6,121,880 to Scott et al.; U.S. Patent No. 5,751,221 to Stanfield et al.; and U.S. Patent No. 6,201,474 to Brady et al.

Applicant traverses these rejections. The following remarks first address the patentability of the claims and then point out the errors in the Patent Office's rejections.

Overview of Patentability

As will be discussed in detail below, claims 1-20 are patentable over the prior art because none of the cited references or no combination of the cited references shows or indicates:

- a file folder with either an embedded RFID transponder or an adhesive RFID transponder
- a file folder with a channel for receiving an antenna
- a file folder with a recess for receiving a transponder circuit
- a file folder with a pair of contacts
- a file folder with contacts and a transponder assembly with contacts
- a label assembly with pressure sensitive adhesive

Requirements for an Obviousness Rejection

The Federal Circuit stated in *In re Oeticker* [977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992)], “[i]f examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent.” The CCPA interpreted *prima facie* obviousness in *In re Lintner* [458 F.2d 1013, 173 USPQ 560, 562 (C.C.P.A. 1972)] as follows:

In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed substitution, combination or other modification.

In *In re Rinehart* [531 F.2d 1048, 189 USPQ 143 147 (C.C.P.A. 1976)], the CCPA added that the *prima facie* case requires that the teachings of the reference “appear to have suggested the *claimed subject matter*.” In view of these decisions, a *prima facie* case of obviousness is established when the Patent Office provides:

- a) one or more references
- b) that were available to the inventor and
- c) that teach
- d) a suggestion to combine or modify the references,
- e) the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art.

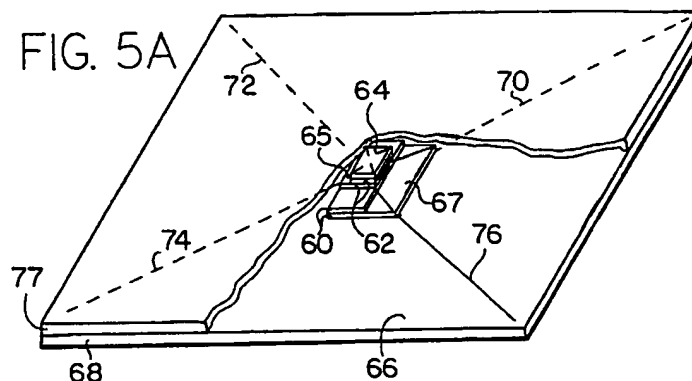
If any one of these elements is not present, the *prima facie* case of obviousness is not established. In the instant case, it is respectfully submitted that the cited references, either alone or in any combination, fail to meet these requirements.

The Cited References

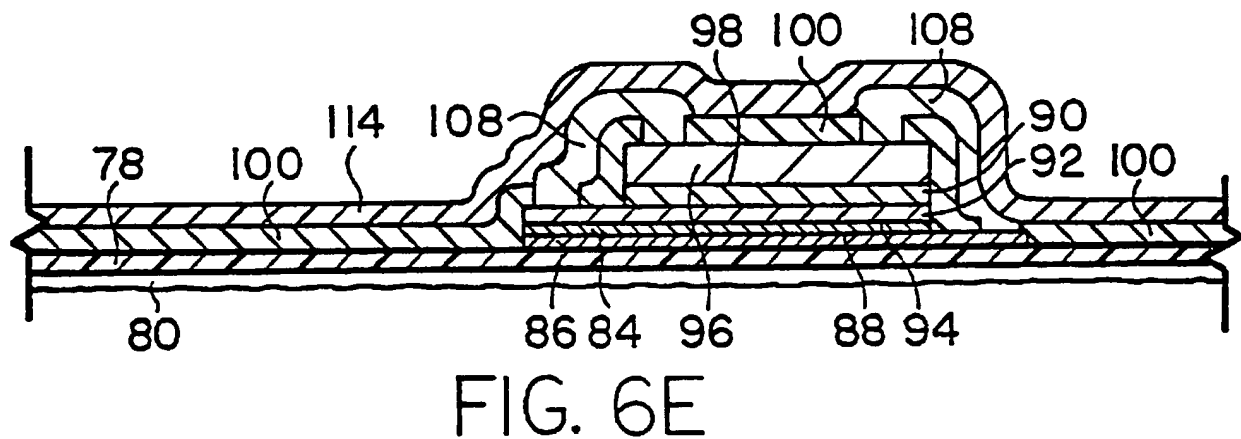
Each of the cited references is now discussed, with the primary reference of Tuttle et al. being discussed first, with the secondary references being discussed thereafter.

U.S. Patent No. 6,045,652 to Tuttle et al.

U.S. Patent No. 6,045,652 to Tuttle et al. discusses a method of manufacturing an enclosed transceiver or integrated circuit (IC). The IC is mounted on a parallel plate capacitor which in turn is mounted on a battery. The enclosed transceiver includes a battery 60, capacitor 62, and IC 64, as shown in simplified FIG. 5E below:



The battery 60 contacts a base support member 68. The capacitor 62 is between the battery 60 and the IC 64. For electrical contacts, exposed area 65 and 67 are provided. Antenna lines 70, 72, 74, and 76 form two dipole antennas connected to opposite corners of IC 64. A polymer cover 77 seals the package to the base support member 68.



As shown in simplified FIG. 6E immediately above, the Tuttle et al. enclosed IC includes the following components (see column 9, lines 1-63):

- a base polymer layer 78
- an adhesive film 80
- conductive epoxy at interface 94 between battery 60 and capacitor 62
- conductive epoxy at interface 98 between capacitor 62 and IC 64
- parallel plates 84 and 86
- a capacitor with parallel plates 90 and 92
- an integrated circuit 96
- a top capacitor plate 90
- conductive epoxy at interface 98
- a prefabricated insulating layer 100 with holes and openings
- a conductive polymer material 108
- shaped conductive epoxy material 108
- a polymer insulating layer 114

Tuttle et al. state at column 3, lines 10-14, that their RFID system and method of operation utilizes RF transmitting and receiving sections on a single IC so that the system has applications for tracking people or articles in both storage and transit.

U.S. Patent No. 5,751,221 to Stanfield et al.

U.S. Patent No. 5,751,221 to Stanfield et al. shows an electronic filing system. A wireless version is shown in FIG. 15 in which RF transceivers 120 are connected to processor 20 and either to each file folder 70 or to each folder retainer, which refers to tray 40, file cabinet 50, shelving unit 60, and desk drawer 86.

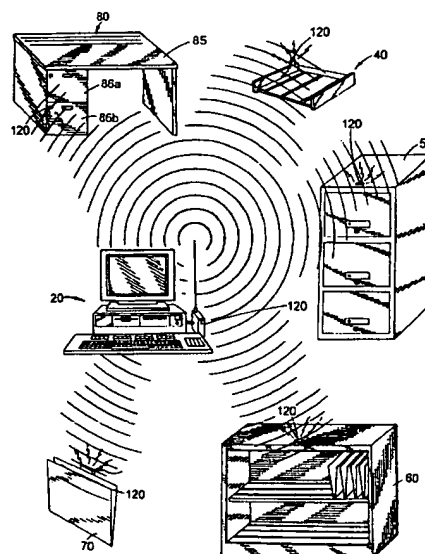


Fig. 15

U.S. Patent No. 5,936,527 to Isaacman et al.

U.S. Patent No. 5,936,527 to Isaacman et al. shows an automatic tag system in FIG. 3 at right that includes a plurality of RFID tags 20 attached to documents (not shown) whose location is desired to be located/identified at some point in time. A plurality of local exciters 18 are placed on the shelves and drawers in an office. A host transceiver 14 is placed in a central location in the office and transmits a radio frequency signal to the local exciter 18. The local exciter 18 transmits a signal to a plurality of tags 20. Thereafter, if one of the tags 20 is selected, then that tag's response is detected by the host 14.

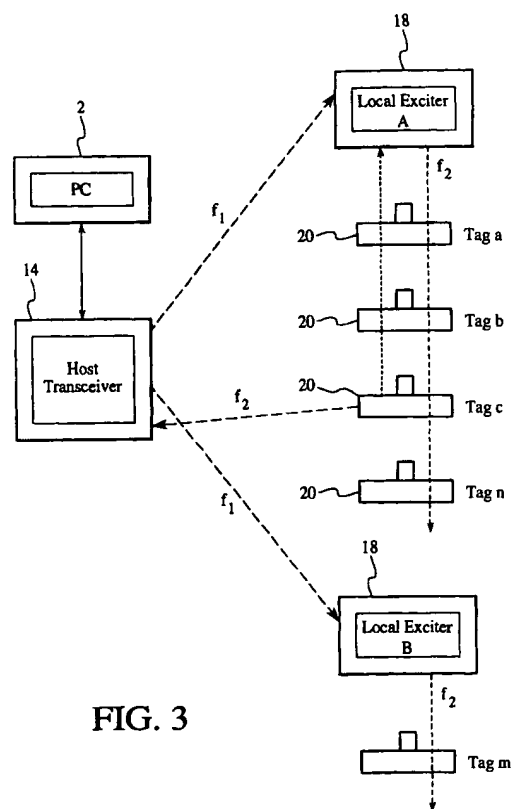


FIG. 3

U.S. Patent no. 6,121,880 to Scott et al.

U.S. Patent No. 6,121,880 to Scott et al. shows a sticker transponder 10 in FIG. 2 below. The transponder 10 includes an adhesive layer 14, a flexible circuit substrate layer 16, and an overlamine layer 18. An ASIC 22 is connected to layer 16. The adhesive layer 14 would ordinarily be covered by a release liner 12. The adhesive layer 14 permits the sticker transponder 10 to be affixed to a glass material surface, such as the vehicle windshield.

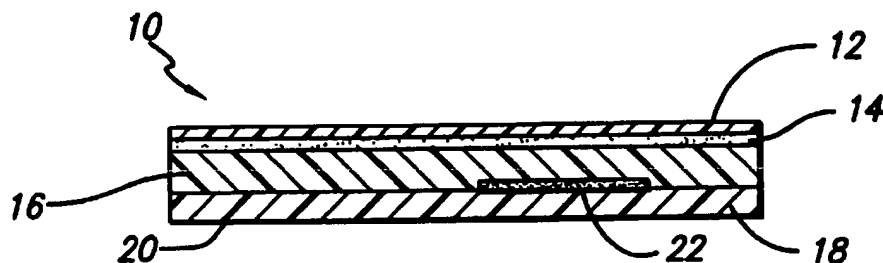
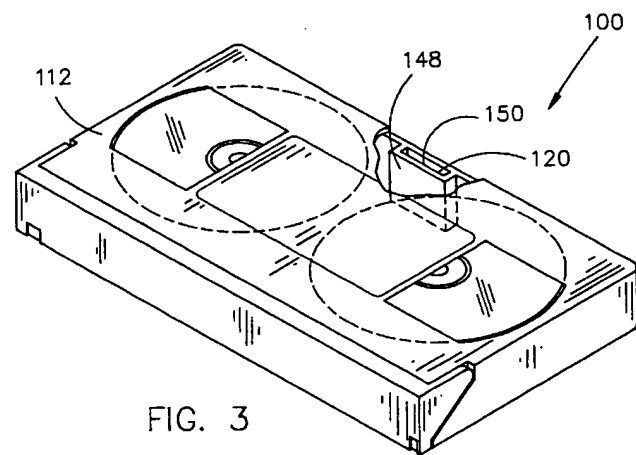


FIG. 2

U.S. Patent No. 6,201,474 to Brady et al.

U.S. Patent No. 6,201,474 to Brady et al. shows a magnetic tape information storage media 100 with an RFID transponder 120 embedded within a wall 148 of a housing 112. As shown in simplified FIG. 3 at right, a slot 150 may be formed in the rear wall of the housing 112. The preassembled RFID transponder 120 is then inserted in the slot 150 as the cassette is assembled.



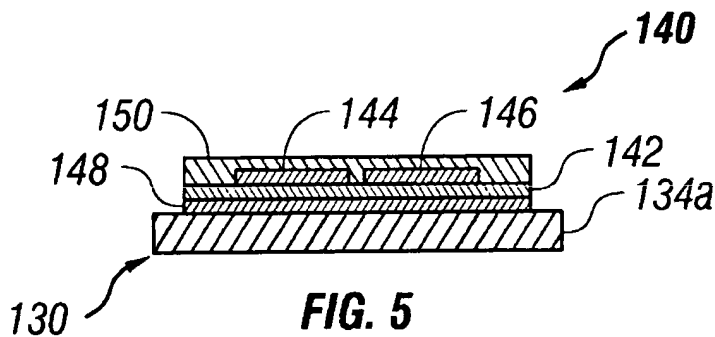
Discussion

Claims 1 and 5-8

Claims 1 and 5-8 stand rejected in view of Tuttle et al. and Stanfield et al. Neither of these two cited patents shows a file as recited in claim 1 which includes a body with a pair of covers and a transponder assembly attached to one of the covers with adhesive. Briefly, claim 1 recites a file including:

a body including a pair of covers; and
a transponder assembly including ... a substrate [and] ... an adhesive layer ... ;
the transponder assembly being attached to one of the covers by the adhesive.

FIG. 5 of the subject application shows an example of the file recited in claim 1, with the claim elements with corresponding reference numerals provided:



file 130
front cover 134a
transponder assembly 140
substrate 142
antenna 144
transponder circuit 146
a layer of adhesive 148

The Tuttle et al. patent shows an encapsulated IC device with an adhesive film. Tuttle et al. discuss possible uses of their device, such as baggage tags, automobiles, letters, boxed mail shipments, animal and plant tracking, and so on. The Stanfield et al. patent shows that an RF transceiver is connected to a file folder. Neither the Tuttle et al. nor Stanfield et al. patent mentions or shows a transponder assembly adhered to a cover of a file.

In contrast to the uniform configuration of the transponder assembly of claim 1, the large and uneven cross-sectional of the Tuttle et al. device as shown in FIG. 6E above would not render a smooth application of the Tuttle et al. device to a cover of a file folder. Indeed, the encapsulated IC of the Tuttle et al. device would project outwardly from the cover if it were attached thereto, rendering an ineffective trackable file. Therefore, on viewing the Tuttle et al. patent, one having ordinary skill in the art would not be motivated to apply the Tuttle et al. device to a cover of a file folder as recited in claim 1.

Accordingly, it is respectfully submitted that a *prima facie* case of obviousness has not been established by the Patent Office because the cited references do not provide any suggestion on how to combine or modify the references, with the combination or modification being sufficient to render the file of claim 1 obvious to one of ordinary skill in the art. Therefore, it is respectfully submitted that claim 1 is patentable over the Tuttle et al. and Stanfield et al. patents and is in condition for allowance.

Claims 5-8 depend from claim 1 and respectively recite additional features of a trackable file. For reasons analogous to those presented in relation to claim 1, it is respectfully submitted that claims 5-8 are also patentable.

Claim 9

Claim 9 stands rejected in view of Tuttle et al., Stanfield et al., and Brady et al. Claims 9 recites that one of the covers may include a recess configured to receive the circuit. Clearly, one skilled in the art would not be motivated to provide a recess in a file folder as recited in claim 9 from a review of the slot 150 of the Brady et al. storage cassette. Accordingly, it is respectfully submitted that a *prima facie* case of obviousness has not been established by the Patent Office because the cited references do not provide any suggestion on how to combine or modify the references, with the combination or modification being sufficient to render the file of claim 9 obvious to one of ordinary skill in the art. Therefore, it is respectfully submitted that claim 9 is patentable over the Tuttle et al., Stanfield et al., and Brady et al. patents and is in condition for allowance.

Claim 10

Claim 10 stands rejected in view of Tuttle et al., Stanfield et al., and Brady et al. Claim 10 recites that the file folder and the circuit may each include a pair of contacts. Clearly, not one of the cited references talks about or shows a file folder with contacts. Accordingly, it is respectfully submitted that a *prima facie* case of obviousness has not been established by the Patent Office because the cited references do not provide any suggestion on how to combine or modify the references, with the combination or modification being sufficient to render the file of claim 10 obvious to one of ordinary skill in the art. Therefore, it is respectfully submitted that claim 10 is patentable over the Tuttle et al., Stanfield et al., and Brady et al. patents and is in condition for allowance.

Claims 16 and 17

Claims 16 and 17 stand rejected in view of Tuttle et al., Stanfield et al., and Brady et al. Claim 16 is an independent claim reciting a file for use with an RFID transponder circuit with a pair of contacts. The file includes:

- a body including a channel and a recess;
- an antenna received in the channel; and
- a pair of contacts one of which being connected to the antenna;
- wherein the transponder circuit is able to be coupled with the pair of contacts of the file when the circuit is received in the recess.

Clearly, neither Tuttle et al., Stanfield et al, nor Brady et al, nor any combination thereof, shows a file with (1) a channel and a recess or (2) a pair of contacts. Claim 17 depends from claim 16. Accordingly, it is respectfully submitted that a *prima facie* case of obviousness has not been established by the Patent Office because the cited references do not provide any suggestion on how to combine or modify the references, with the combination or modification being sufficient to render the respective files of claims 16 and 17 obvious to one of ordinary skill in the art. Therefore, it is respectfully submitted that claims 16 and 17 are patentable over the Tuttle et al., Stanfield et al., and Brady et al. patents and is in condition for allowance.

Claims 3, 12, and 13

Claims 3, 12, and 13 stand rejected in view of Tuttle et al., Stanfield et al., and Isaacman et al.

Claim 3 sets forth a system for tracking objects including a plurality of antenna arrays, a plurality of files, a reader, and an administrator. The files include a transponder assembly attached to a cover, analogous to the file of claim 1 discussed above. Claims 12 and 13 depend from claim 3 and respectively recite additional features of the system.

The Tuttle et al. and Stanfield et al. patents are discussed above in relation to claim 1. Isaacman et al. shows an automatic tag system but does not provide any motivation to one skilled in the art to attached the encapsulated IC of the Tuttle et al. patent to a file folder.

Accordingly, it is respectfully submitted that a *prima facie* case of obviousness has not been established by the Patent Office because the cited references do not provide any suggestion on how to combine or modify the references, with the combination or modification being

sufficient to render the system of claim 3 obvious to one of ordinary skill in the art. Therefore, it is respectfully submitted that claims 3, 12, and 13 are patentable over the combination of Tuttle et al., Stanfield et al., and Isaacman et al. patents and are in condition for allowance.

Claims 4, 14, and 15

Claims 4, 14, and 15 stand rejected in view of Tuttle et al. and Scott et al.

Claim 4 sets forth a label transponder assembly including a transponder assembly and a backing sheet. The transponder assembly includes a transponder assembly and a backing sheet. The transponder assembly has a substrate with pressure sensitive adhesive such that the transponder assembly is releasably attachable to objects. Claims 14 and 15 depend from claim 4.

The Tuttle et al. patent and the Scott et al. patent do not show or describe a label assembly with pressure sensitive adhesive. Accordingly, it is respectfully submitted that a *prima facie* case of obviousness has not been established by the Patent Office because the cited references do not provide any suggestion on how to combine or modify the references, with the combination or modification being sufficient to render the file of claim 4 obvious to one of ordinary skill in the art. Therefore, it is respectfully submitted that claims 4, 14, and 15 are patentable over the Tuttle et al. and Scott et al. patents and are in condition for allowance.

Claim 17

Claim 17 stands rejected in view of Tuttle et al., Scott et al., Stanfield et al., and Brady et al. Claim 17 has been amended to depend from claim 16 discussed above, and recites that the contacts of the file of claim 16 are disposed in a recess.

None of the cited patents, either alone or in any combination show a file with a pair of contacts disposed in a recess. Accordingly, it is respectfully submitted that a *prima facie* case of obviousness has not been established by the Patent Office because the cited references do not provide any suggestion on how to combine or modify the references, with the combination or modification being sufficient to render the file of claim 17 obvious to one of ordinary skill in the art. Therefore, it is respectfully submitted that claim 17 is patentable over the Tuttle et al. and Scott et al. patents and in condition for allowance.

Claims 18-20

Claims 18-20 stand rejected in view of Tuttle et al. and Scott et al.

Claim 18 recites a transponder label assembly *consisting of* a transponder assembly and a backing sheet. The transponder assembly includes a substrate, an antenna, a transponder circuit, and an adhesive layer. Claims 19 and 20 have been amended to depend from claim 18. Claims 19 and 20 have been amended to depend from claim 18.

As discussed above, the Tuttle et al. encapsulated IC includes numerous required elements. The Scott et al. sticker transponder includes an overlamine so that the transponder can be adhered to a vehicle windshield and withstand the weather and driving conditions.

There is no suggestion in either of these two patents of a label assembly consisting only of a transponder assembly and a backing sheet. Accordingly, it is respectfully submitted that a *prima facie* case of obviousness has not been established by the Patent Office because the cited references do not provide any suggestion on how to combine or modify the references, with the combination or modification being sufficient to render the file of claim 18 obvious to one of ordinary skill in the art. Therefore, it is respectfully submitted that claims 18-20 are patentable over the Tuttle et al. and Scott et al. patents and in condition for allowance.

ALLOWABLE SUBJECT MATTER

Claim 11 has been rejected for indefiniteness but has not been rejected in view of the prior art. It is respectfully submitted that the amendment of claim 11 overcomes the rejection for indefiniteness.

Claim 11 depends from claim 10 and recites that a circuit is a separate circuit for coupling with a pair of contacts of the file by an end user. Clearly, none of the cited patents shows a separate circuit for coupling to a file by a user. It is, therefore, respectfully submitted that claim 11 is patentable and in condition for allowance.

NEW CLAIMS

New claims 21-24 have been added to more particularly point out and distinctly claim the subject matter which applicant regards as the invention. Support for the new claims 21 and 22 may be found, for example, in paragraphs 0049 and FIGS. 11 and 12. Support for new claims 23 and 24 may be found, for example, in paragraph 0043.

New claim 21 is an independent claim reciting a method of utilizing an RFID label to retrofit an object for tracking. Claim 22 depends from new claim 21 and sets forth an embodiment in which a plurality of objects are retrofitted. Claims 23 and 24 recite embodiments in which pressure sensitive adhesive is used so that the transponder assemblies are removable from objects.

Clearly, as discussed at length above, none of the cited references talks about retrofitting objects for tracking, particularly utilizing an RFID label with a backing sheet. Accordingly, it is respectfully submitted that new claims 21-24 are patentable and in condition for allowance.

CLOSING COMMENTS

In view of the foregoing remarks, it is respectfully submitted that the subject application, including claims 1-24, is in condition for allowance. Early notification of the same is respectfully requested.

The Examiner is invited to contact the undersigned if he believes there are any issues which may remain preventing the allowance of the claims and the passage of the application to issue.

Respectfully submitted,



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